

## Remarks

### I. Introduction

This is in response to the Office Action dated August 13, 2008. The Office Action rejected claims 1-19 and 22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0128356 to Bernstein et al. ("Bernstein") in view of U.S. Patent Application Publication No. 2003/0229670 to Beyda ("Beyda"). Claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over Bernstein in view of Beyda, further in view of U.S. Patent Application Publication No. 2002/0065894 to Dalal et al. ("Dalal").

Claims 1-20 and 22 remain for consideration. Claim 21 was previously cancelled.

### II. Rejections under 35 U.S.C. §103

Independent claims 1, 9, 10, and 14 were rejected as being unpatentable over Bernstein in view of Beyda. In order to "establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03. Neither of the cited references, either alone or in combination, teach all of the claim limitations of independent claims 1, 9, 10, and 14. Therefore, Applicants request the withdrawal of the rejections under 35 U.S.C. §103(a).

The subject area of the present invention generally relates to communications and more particularly to integrating instant messaging (IM) and email (page 1, lines 20-21; page 7, lines 11-12). Page 8, lines 18-23 of the Specification describe one embodiment of the present invention in which an IM user agent 104 and email user agent 106 are configured to communicate with address book object 108, all of which are shown in Figure 1.

Figure 18B depicts a flowchart showing an embodiment described on page 44 lines 6-18 of the Specification as follows:

The method begins when an email message from a sender is displayed (1820) to the user at an email read window. The email message includes an email address of the sender. Upon displaying (1820) the email message to the user, the system determines (1850) whether or not the sender is present online...If the sender is present, then an IM session is initiated (1860) between the user (recipient) and the sender.

The aspect of determining the presence of a contact is claimed in claim 1 which recites the limitation of “determining, by an instant messaging client, an internet presence of a contact identified in an email message.” The cited references, either alone or in combination, do not disclose or suggest this limitation and as such, cannot render independent claim 1 unpatentable.

The Office Action states that Bernstein discloses “determining an Internet presence of a contact identified in an email message” on page 2, paragraphs [0016] and [0017] and on page 1, paragraph [0007].

Bernstein discloses a system and method supporting instant messaging through the use of universally unique identifiers to web pages for instant messaging sessions, with recipients invited to the instant messaging session via email. (Bernstein Abstract)

Bernstein Paragraph [0016] states that “[u]pon receipt of the email invitation, the recipient initiates an Instant Messaging conversation with the sender (who’s [sic] acceptance is implicit since the sender initiated the Instant Messaging request). Bernstein Paragraph [0017] states that “[t]his email becomes the implicit ‘permission’ for the recipient to converse with the sender, so no other action is required on the part of the sender.” The Office Action also cites paragraph [0007] of Bernstein which is located in the “Background Art” section of the application and discloses the ‘privacy problem’ in the context of traditional Instant Messaging environments. The receipt of an email does not, by itself, determine the internet presence of the contact identified in the email. Thus, the sections of Bernstein cited by the Office Action do not disclose or suggest either “determining, by an instant messaging client, an internet presence” or

“determining,...,an internet presence of a contact identified in an email message” as recited in claim 1.

The Office Action admits that “Bernstein does not specifically disclose [that] the presence of the contact is determined by an instant messaging client.” The Office Action states that Beyda provides the missing limitation indicating that “Beyda discloses [that] the presence of the contact is determined by an instant messaging client.”

Beyda discloses a method and apparatus for using instant messaging as a notification tool. The Office Action cites paragraph [0022] of Beyda which states “user’s online presence may still be detected or monitored by an instant messaging system” and paragraph [0029] which states “instant messaging server, service or system and thereby capable of detecting or monitoring the online presence.” However, the detection of a user’s online presence **by an instant messaging system** is not the same as determining “an internet presence of a contact identified in **an email message**” as recited in claim 1. This is because an email, unlike an instant message, does not indicate that the contact is presently online. None of the sections of Beyda cited by the Office Action with respect to claim 1 disclose determining “an internet presence of a contact identified in an email message” as recited in claim 1.

Since, for reasons discussed above, Bernstein and Beyda, either alone or in combination, do not disclose or suggest each and every limitation of independent claim 1, Bernstein and Beyda cannot render independent claim 1 unpatentable. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 1 under 35 U.S.C. §103(a) over Bernstein and Beyda.

Independent claims 9, 10, and 14 recite the limitations of “means for, at an instant messaging client, determining an Internet presence of a contact identified in an email message”; “presence logic, at an instant messaging client, configured to determine an Internet presence of a contact identified in an email message”; and “computer-readable code adapted to instruct a programmable device to determine, at

an instant messaging client, an Internet presence of a contact from an email message” respectively.

These limitations are similar to the claim 1 limitation of “determining, by an instant messaging client, an internet presence of a contact identified in an email message” and were rejected by the Office Action for the same reasons stated in the Office Action for claim 1. It follows that the each and every limitation of independent claims 9, 10, and 14 are not disclosed or suggested by the cited references for the same reasons discussed above in connection with independent claim 1. Since Bernstein and Beyda, either alone or in combination, fail to disclose or suggest each and every limitation of claim 9, 10, and 14, the cited references cannot render claims 9, 10, and 14 unpatentable. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 9, 10, and 14 under 35 U.S.C. §103(a) over Bernstein in view of Beyda.

For the reasons discussed above, all independent claims are allowable over the rejections and objections cited in the Office Action. Allowance of all independent claims is requested.

All remaining dependent claims are dependent upon an allowable independent claim and are therefore also allowable. These dependent claims are also allowable because they add additional allowable subject matter as follows.

The Office Action rejected dependent claim 2 under 35 U.S.C. §103(a). Dependent claim 2 further limits the method of claim 1 stating “wherein initiating the IM chat session comprises” and reciting the additional limitations of “obtaining information from the email message” and “displaying the obtained information in the generated IM chat window.” The Office Action states that these limitations are disclosed by Bernstein paragraphs [0023] and [0093]-[0100]. Paragraph [0023] of Bernstein discloses an “IM area [that] is rendered within the email message.” Paragraphs [0093]-[0100] of Bernstein disclose a “URL contained in the email initiating the whole Instant Messaging

session always contains that unique ID” and that “[t]he user whenever looking at that email at any time in the future, will trigger the server to attempt fetching all the Instant Messaging messages has [sic] stored for that email. The email will then continue to display to the user the complete Instant Messaging transcript associated with the email.” Thus, the cited sections of Bernstein disclose displaying information stored on a server in an IM chat window. Bernstein does not disclose or suggest “obtaining information from the email message” and “displaying the obtained information in the generated IM chat window” as recited by claim 2. As such, Bernstein cannot render claim 2 unpatentable. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 2 under 35 U.S.C. §103(a).

The Office Action rejected dependent claims 11 and 15 under 35 U.S.C. 103(a) for the same reasons set forth for claim 2. As such, claims 11 and 15 cannot be rendered unpatentable by Bernstein for the same reasons discussed above in connection with claim 2. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 11 and 15 under 35 U.S.C. §103(a).

Dependent claim 3 was rejected under 35 U.S.C. 103(a) as being rendered obvious by Bernstein in view of Beyda. Dependent claim 3 adds the limitation “wherein obtaining information from the email messages comprises: obtaining a subject of the email message. The sections of Bernstein cited by the Office Action do not disclose or suggest “obtaining the subject of the email message” and as such, Bernstein cannot render dependent claim 3 unpatentable. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 3 under 35 U.S.C. §103(a).

Dependent claims 12 and 16 were rejected under 35 U.S.C. 103(a) for the same reasons set forth for claim 3. As such, claims 12 and 16 cannot be rendered unpatentable by Bernstein for the same reasons discussed above in connection with claim 3. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 12 and 16 under 35 U.S.C. §103(a).

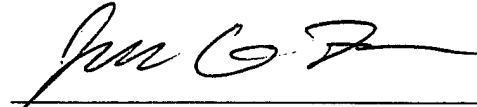
Dependent claim 4 was rejected under 35 U.S.C. §103(a) as being rendered obvious by Bernstein in view of Beyda. Dependent claim 4 adds the limitation of “displaying the subject of the email message in the generated IM chat window.” Since, Bernstein does not disclose or suggest “obtaining a subject of the email message” for reasons discussed above in connection with dependent claim 3, Bernstein cannot disclose “displaying the subject of the email message” because Bernstein does not disclose or suggest obtaining the subject of the email message. As such, Bernstein cannot render claim 4 unpatentable. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 4 under 35 U.S.C. §103(a).

Dependent claims 13 and 17 were rejected under 35 U.S.C. 103(a) for the same reasons set forth for claim 4. As such, claims 13 and 17 cannot be rendered unpatentable by Bernstein for the same reasons discussed above in connection with claim 4. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 13 and 17 under 35 U.S.C. §103(a).

III. Conclusion

For the reasons discussed above, all pending claims are allowable over the rejections and objections cited in the Office Action. Reconsideration and allowance of all claims is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Joe G. Fenske", written over a horizontal line.

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